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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/657,655

09/08/2003

Mark Kogen

CIT10262

2843

27510

7590

11/17/2006

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EXAMINER

LEMMA, SAMSON B

ART UNIT

PAPER NUMBER

2132

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/657,655	Applicant(s) KOGEN ET AL.	
	Examiner Samson B. Lemma	Art Unit 2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2003.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## ***DETAILED ACTION***

1. This office action is in reply to an application filed on September 08, 2003.

**Claims 1-19** are pending.

### ***Priority***

2. This application does claims priority of a provisional application 60/408616, filed on 09/06/2002. Therefore, the effective filing data for the subject matter defined in the pending claims of this application is **09/06/2002**.

### ***Double Patenting***

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. **Claims 1-19 of this application conflict with claims 1-44 of Application**

**No.10/985,414** (see claim-comparison below). 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

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5. **Claims 1-19** are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of the **claims 1-44** of the copending Application No.

**10/985,414** (hereinafter referred to as '**414 application**.)

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**The following is referring to the independent claims**

- **As per independent claims 1 and 19, all elements of claims 1 and 19** of the instant application and **claim 1** of the '**414 application** recites same limitation. **In other words each elements of claims (1 and/or 19)** of the instant application corresponds to **claim 1 of the '414 application**.

**The following is referring to the dependent claims**

- **As per claim 2, claim 2** of the instant application and **claim 2** of the '**414 application** further recite same limitation of the same subject matter.
- **As per claim 3, claim 3** of the instant application and **claim 3** of the '**414 application** further recite same limitation of the same subject matter.
- **As per claim 4, claim 4** of the instant application and **claim 4** of the '**414 application** further recite same limitation of the same subject matter.
- **As per claim 5, claim 5** of the instant application and **claim 6** of the '**414 application** further recite same limitation of the same subject matter.

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- **As per claim 6, claim 6** of the instant application and **claim 7** of the '414 application further recite same limitation of the same subject matter.
- **As per claim 7, claim 7** of the instant application and **claim 9** of the '414 application further recite same limitation of the same subject matter.
- **As per claim 8, claim 8** of the instant application and **claim 10** of the '414 application further recite same limitation of the same subject matter.
- **As per claim 9, claim 9** of the instant application and **claim 11** of the '414 application further recite same limitation of the same subject matter.
- **As per claim 10, claim 10** of the instant application and **claim 12** of the '414 application further recite same limitation of the same subject matter.
- **As per claim 11, claim 11** of the instant application and **claim 14** of the '414 application further recite same limitation of the same subject matter.
- **As per claim 12, claim 12** of the instant application and **claim 15** of the '414 application further recite same limitation of the same subject matter.
- **As per claim 13, claim 13** of the instant application and **claim 16** of the '414 application further recite same limitation of the same subject matter.

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- **As per claim 14, claim 14** of the instant application and **claim 17** of the '414 application further recite same limitation of the same subject matter.
- **As per claim 15, claim 15** of the instant application and **claim 19** of the '414 application further recite same limitation of the same subject matter.
- **As per claim 16, claim 16** of the instant application and **claim 20** of the '414 application further recite same limitation of the same subject matter.
- **As per claim 17, claim 17** of the instant application and **claim 21** of the '414 application further recite same limitation of the same subject matter.
- **As per claim 18, claim 18** of the instant application and **claim 22** of the '414 application further recite same limitation of the same subject matter.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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7. **Claims 1-19** are rejected under 35 U.S.C. 102(e) as being anticipated by **Hwangbo** (hereinafter referred as **Hwangbo**)(U.S. Publication No. 2003/0154376 A1) (filed on February 16, 2001)
8. **As per claims 1 and 11-19** **Hwangbo discloses a method for combining multiple access points and utilizing a certificate as an access method to a host system from one of a plurality of access points, comprising:**

**Creating and distributing a certificate for certificate-based authentication to any one of a plurality of storage methods selected from a group of storage methods consisting of at least a microcomputer of an integrated chip card, a disk of a computer disposed in a secure environment, and a hardware security module (HSW) associated with a computer** [paragraphs 0011-0012] (As explained on paragraph 0011, The user sends a digital certificate request message PKCS#10 containing the token issued from the registration authority and his or her public key to the certification authority server to request it to issue the digital certificate (step 6). The certification authority server verifies the validity of the certificate request message sent from the user (step 7) and sends a certificate request response message to the user, that is, issues the digital certificate to the use. The certification authority server then stores the issued digital certificate in a digital certificate depository (X.500 directory or LDAP server) (step 8) and meanwhile sends it to the user (step 9), this meets the limitation of "creating and distributing a certificate for certificate based authentication". And on paragraph 0012, the following has been disclosed. The user downloads the digital certificate from the certification authority server and preserves it in a storage medium, such as a hard disk, diskette, integrated circuit (IC) card, smart card or the like, and this meets the limitation of "any one of a plurality of storage methods selected from a group of storage methods consisting of at least a microcomputer of an integrated

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chip card, a disk of a computer disposed in a secure environment, and a hardware security module (HSW) associated with a computer” )

**managing the certificate over a life span of the certificate [paragraph 0096]**

(The user certificate is provided with a basic field 150a and extension field 150b on the basis of a certificate standard X.509. Stored in the basic field 150a of the user certificate are general information written on the optical storage medium 150, such as a user's name, serial number, expiry date, issuer's name, E-mail address, etc.) **at least in part via a lightweight directory assistance protocol (LDAP) directory shared by a certificate authority (CA)** [Paragraph 0011] (The **certification authority** server verifies the validity of the certificate request message sent from the user (step 7) and sends a certificate request response message to the user, that is, issues the digital certificate to the user. The certification authority server then stores the issued digital certificate in a digital certificate depository (**X.500 directory or LDAP server**) (step 8) and meanwhile sends it to the user (step 9)) **and a card life cycle management system**

**(CCLCMS)** [This is an inherent feature included in a digital Identity implementation, specially on the smartcard, see for instance page 24, the last slide, reference U ] ; and

**allowing access to the host system using the certificate for public key-based authentication to an application on a host server.** [This is an inherent feature of a smartcard, see page 15-16 reference U, this is an inherent feature of a smartcard, see about the role of the smart card and what do smart card add, “the smart card is the single-sign-on authentication token for convenient, secure and mobile access to network based service and executes e-signatures for non-



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repudiable e-transaction, see also on page 15, how the smart card is used for financial transactions and electronic purchasing.)

9. **As per claims 2-3 and 6-10 Hwangbo discloses a method as applied to claims above. Furthermore Hwangbo discloses the method, wherein creating and distributing the certificate further comprises creating and distributing the certificate for storage on the microcomputer of the integrated chip card.**[Paragraph 0011-0012] (On paragraph 0011-0012] (As explained on paragraph 0011, The user sends a digital certificate request message PKCS#10 containing the token issued from the registration authority and his or her public key to the certification authority server to request it to issue the digital certificate (step 6). The certification authority server verifies the validity of the certificate request message sent from the user (step 7) and sends a certificate request response message to the user, that is, issues the digital certificate to the use. The certification authority server then stores the issued digital certificate in a digital certificate depository (X.500 directory or LDAP server) (step 8) and meanwhile sends it to the user (step 9), this meets the limitation of "creating and distributing a certificate". And on paragraph 0012, the following has been disclosed. The user downloads the digital certificate from the certification authority server and preserves it in a storage medium, such as a hard disk, diskette, integrated circuit (IC) card, smart card or the like, and this meets the limitation of "**certificate for storage on the microcomputer of the integrated chip card**")]

10. **As per claim 4 Hwangbo discloses a method as applied to claims above. Furthermore Hwangbo discloses the method,** wherein creating and distributing the certificate for storage on the microcomputer of the integrated chip card further comprises creating and signing the certificate by the CA in response to a request for the certificate received via a registration authority (RA).

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[paragraph 0010] (As explained on paragraph 0011, The user sends a digital certificate request message PKCS#10 containing the token issued from the registration authority and his or her public key to the certification authority server to request it to issue the digital certificate (step 6). The certification authority server verifies the validity of the certificate request message sent from the user (step 7) and sends a certificate request response message to the user, that is, issues the digital certificate to the use. The certification authority server then stores the issued digital certificate in a digital certificate depository (X.500 directory or LDAP server) (step 8) and meanwhile sends it to the user (step 9))

11. **As per claim 5 Hwangbo discloses a method as applied to claims above.**

**Furthermore Hwangbo discloses the method**, wherein creating and distributing the certificate for storage on the microcomputer of the integrated chip card further comprises posting a **copy of the certificate to the LDAP directory shared by the CA and the CCLCMS in a location in which log-in rights and access rights for a holder of the card are identified to the CLCMS.**[Paragraph 0010] (As explained on paragraph 0011, The user sends a digital certificate request message PKCS#10 containing the token issued from the registration authority and his or her public key to the certification authority server to request it to issue the digital certificate (step 6). The certification authority server verifies the validity of the certificate request message sent from the user (step 7) and sends a certificate request response message to the user, that is, issues the digital certificate to the use. The certification authority server then stores the issued digital certificate in a digital certificate depository (X.500 directory or LDAP server) (step 8) and meanwhile sends it to the user (step 9) AND see also page 24, the last slide, reference U inherent feature included in a digital Identity implementation, specially on the smartcard.)

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### **Conclusion**

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.(See PTO-Form 892).

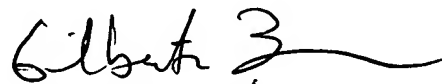
Any inquiry concerning this communication or earlier communications from the examine should be directed to Samson B Lemma whose telephone number is 571-272-3806. The examiner can normally be reached on Monday-Friday (8:00 am---4: 30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, BARRON JR GILBERTO can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**SAMSON LEMMA**

**S.L.**  
**10/28/2006**



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